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EXAMINER	
RANKINS, WILLIAM E	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID LAWRENCE

Appeal 2009-010098
Application 10/801,238
Technology Center 3600

Before: MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1, 3-9. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is directed to systems and methods for making shares of stock for an initial public offering (IPO) available through pre-auction and auction processes (Spec. 1:7-10). Claim 1, reproduced below, is further illustrative of the claimed subject matter.

> 1. A computer implemented method for allocating shares of stock comprising an initial public offering, the method comprising:
>
> offering in a computer system, a subset of the shares to one or more pre-auction bidders at a pre-auction price;
>
> receiving into a memory in the computer system, an indication from the one or more pre-auction bidders accepting the offer for the shares at the pre-auction price;
>
> publishing in the computer system, information descriptive of one or more pre-auction sales of shares comprising the initial public offering, said information descriptive of the pre-auction sales of shares including the pre-auction price and identification of bidders who bought shares at the pre-auction price;
>
> accepting into the memory in the computer system, the offer for shares at the pre-auction price; and
>
> auctioning with a processor in the computer system, the remaining shares.

The references of record relied upon by the Examiner as evidence of obviousness are:

Moshal	US 2001/0042041 A1	Nov. 15, 2001
Sheehan	US 2001/0049647 A1	Dec. 06, 2001
Buist	US 2002/0035534 A1	Mar. 21, 2002
Hoffman	US 2002/0049664 A1	Apr. 25, 2002
Eckert	US 2002/0069161 A1	Jun. 06, 2002

Agarwal	US 2002/0099646 A1	Jul. 25, 2002
Maltzman	US 2002/0107779 A1	Aug. 08, 2002
Ausubel	US 2004/0054551 A1	Mar. 18, 2004
Sloan	US 2005/0091140 A1	Apr. 28, 2005

Claims 1, 3-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maltzman, Moshal, Sloan, Sheehan, Buist, Ausubel, Agarwal, Hoffman, and Official Notice.

We AFFIRM.

ISSUE

Did the Examiner err in asserting that a combination of Maltzman, Moshal, Sloan, Sheehan, Buist, Ausubel, Agarwal, Hoffman, and Official Notice renders obvious the subject matter of claims 1, 3-9?

FINDINGS OF FACT

We adopt the Examiner's Finding of Fact concerning Maltzman, as set forth on pages 5-15 of the Examiner's Answer.

Moshal

Moshal discloses that EBAY offers an Internet auction house, primarily for consumers. Sellers on EBAY may provide items for sale using traditional bidding auctions, Dutch auctions, or reserve price auctions. The seller chooses the type of auction before it begins. The auction is then carried out for a duration of time to its completion. Once started, the user cannot change the conditions of the auction (para. [0006]).

Brokers now offer users Internet-access to the public stock exchanges across the globe. Users can purchase securities on such exchanges using

Internet terminals. Users can view real-time bid and ask offers for securities, and submit offers for the securities that are electronically delivered to the dealers of the securities (para. [0007]).

In general, auction and electronic exchanges offer limited variations. Any variation to implementation of electronic exchanges is made through selection amongst entire auction systems (para. [0008]).

An embodiment of Moshal includes a method or system for plurality of exchanges, conducted over a network between a set of sellers and a set of bidders. The set of sellers includes at least a first seller on a first terminal coupled to the network. The set of bidders includes at least a first bidder on a second terminal coupled to the network. Each exchange is conducted to determine a transactional value of an item. A plurality of parameters are identified with each of the plurality of requests to configure the exchange according to a combination of instructions (para. [0009]).

ANALYSIS

We are not persuaded that the Examiner erred in asserting that a combination of Maltzman, Moshal, Sloan, Sheehan, Buist, Ausubel, Agarwal, Hoffman, and Official Notice renders obvious the subject matter of claims 1, 3-9 (App. Br. 6-9). Appellant asserts that Maltzman and the claimed invention are not analogous art because Maltzman is not concerned with preventing problems related to underpricing and corruption of IPOs (App. Br. 7-8). However, both Maltzman and the claimed invention are directed to pre-auction and auction processes. Accordingly, both are in the same field of endeavor, and thus meet the first prong of the analogous arts test. *See In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (the test for

determining whether a reference is analogous art is (1) whether the reference is in the field of the Appellant's endeavor or (2) whether the reference is reasonably pertinent to the problem with which the Appellant was concerned). As for the fact that Maltzman is not related to IPOs, the Examiner cites Moshal for disclosing IPOs in auction processes. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) (*citing In re Young*, 403 F.2d 754 (1968) (one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references). With regards to underpricing and corruption, if the cited references render obvious the components of the claimed invention, the combination of cited references also accrues the advantages of the claimed invention.

Appellant also asserts that there is no reason for combining Maltzman and Moshal, because Moshal only discloses alternative techniques for online trading (App. Br. 8-9). However, Moshal discloses that it is known to offer securities, such as IPOs, on auction exchanges. The Examiner asserts that one of ordinary skill would integrate the securities and IPOs of Moshal into the pre-auction and auction processes of Maltzman to expand the universe of goods and services available for pre-auction and auction in Maltzman (Exam'r's Ans. 6, 14-15; Moshal paras. [0006]-[0009]). We agree.

We AFFIRM the Examiner's 35 U.S.C. § 103(a) rejection of claims 1, 3-9.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1) (2007).

AFFIRMED

hh

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